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REMARKS

Double Patenting

All claims in the present application are rejected in the Office Action dated September 24, 2004 for obviousness-type double patenting over claims 1-22 of copending Application No. 09/882174, over claims 10-15 of copending Application No. 09/881915, over claims 1-20 of copending Application No. 09/881917, and over claims 1-12 of copending Application No. 09/882173.

The Office Action states that claims 1-27 are rejected as being unpatentable over claims 10-15 of copending Application No. 09/881915 because:

... they are not patentably distinct from each other because the limitations of the independent claims 1, 7, 10, 16, 19, and 25 are similar to claim 1 of copending Application No. 09/881915. The limitations 'remote direction of streaming digital content from a content server to a client devices using remote director' is equivalent to the use of a content server through which digital content is transcoded into streams of multimedia data, the streams communicated via network to client devices, use of the digital content for streaming, use of remote director instructions comprising hyperlinked URLs invoked through a network-capable device. The concept of the use of macro control and macro instructions is well known in the art.

The law governing double patenting is that the analysis employed in an obviousness-type double patenting determination parallels the guidelines for a 35 U.S.C. 103(a) rejection. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966) are applied for establishing a background for determining obviousness under 35 U.S.C. 103 and are employed when making an obviousness-type double patenting rejection. The *Graham* factual inquiries require the Examiner to:

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- determine the scope and content of the art as described in copending application no. No. 09/881915;
- determine the differences between the scope and content of the art as described in copending application no. No. 09/881915 and the claims at issue;
- determine the level of ordinary skill in the pertinent art; and
- evaluate any objective indicia of nonobviousness.

The Office Action Fails to Establish the Required
Background for the Double Patenting Rejection

As described above, the Office Action must apply the Graham factors to establish the required background for a double patenting rejection. The Office Action fails to apply a single Graham factor to establish any of the necessary background elements for determining obviousness. In fact, the Office Action does not even mention the *Graham* factors. In the complete absence of any mention or consideration of the Graham factors whatsoever, applicants can offer no further analysis on this issue. The Office Action clearly cannot support an obviousness-type double patenting rejection, and the rejection should be withdrawn.

The Office Action Fails to State Reasons Why a Person of Skill
in the Art Would Conclude that the Claims are Obvious

The Office Action presents no argument why a person of ordinary skill in the art would conclude that claims 1-27 in the present case are obvious in view of claims 10-15 of copending Application No. 09/881915. In fact, the Office Action says not one word regarding why a person of ordinary skill in the art would conclude that claims 1-27 in the present case are obvious in view of claims 10-15 of copending Application No. 09/881915. The Office Action therefore cannot

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support an obviousness-type double patenting rejection and the rejection should be withdrawn.

Summary Regarding Double Patenting

The double patenting rejections of the claims of the present application over claims 1-22 of copending Application No. 09/882174, over claims 10-15 of copending Application No. 09/881915, over claims 1-20 of copending Application No. 09/881917, and over claims 1-12 of copending Application No. 09/882173 should be withdrawn for the same reasons as set forth above for the rejections over claims 1-12 of copending Application No. 09/882173. In summary regarding the double patenting rejections, therefore: The Office Action of September 24, 2004, does not establish the necessary background for determining obviousness required by an obviousness-type double patenting rejection. Furthermore, the Office Action fails to articulate reasons why a person of ordinary skill in the art would conclude that claims 1-27 in the present case are obvious in view of claims 1-22 of copending Application No. 09/882174, over claims 10-15 of copending Application No. 09/881915, over claims 1-20 of copending Application No. 09/881917, and over claims 1-12 of copending Application No. 09/882173. The rejection of claims 1-27 for double patenting should therefore be withdrawn.

Title of The Application

There is no need to amend the title of the present application. The Office Action states:

The present title is not sufficient for proper classification of the claimed subject matter.

Applicants in response respectfully note that 37 C.F.R. § 1.72(a) requires titles to be "as short and specific as possible." The title of the present application is "Macro Facilities for Direction of Video Streaming." Applicants propose that the title is short, specific,

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descriptive, and in complete compliance with 37 CFR § 1.72(a). Applicants therefore respectfully decline to amend the title.

Brief Summary of the Invention

There is no need to amend the Summary. The Office Action states:

The 'Brief Summary of the Invention' should contain brief description of the disclosed subject matter rather repetitive claimed language of the claims.

Applicants respectfully note that 37 C.F.R. §1.73 requires, "Such summary should, when set forth, be commensurate with the invention as claimed and any object recited should be that of the invention as claimed." Applicants use claim terminology to assure compliance with 37 C.F.R. § 1.73. Applicants respectfully propose that claim terminology is the very best terminology for compliance with 37 C.F.R. 1.73 because claim terminology is assured to be "commensurate with the invention as claimed." For these reasons, applicants respectfully decline to amend the Brief Summary of Invention.

Drawings

The Office Action requests the submission of formal drawings. Formal drawings were submitted on January 29, 2004, and are currently available on PAIR. In an effort to move the case forward and for Examiner Patel's examining convenience, Applicants submit with this Response a copy the formal drawings as filed on January 29, 2004. The objection to the drawings should be withdrawn.

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Rejections – 35 U.S.C. § 112The Office Action Fails To State A Prima Facie Case Of
Inadequate Written Description Under 35 USC 112.

The Office Action states, "Claim 2 is rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention." The Office Action states "Claim 2 recites the limitation "the original raw form". There is insufficient antecedent basis for this limitation in the claim:" In response, Applicants have amended claim 2 to read "an original raw form." Applicants therefore respectfully request withdrawal of this ground of rejection.

Claim Rejections – 35 U.S.C. § 103

Claims 1-27 are in the case. Applicants have renumbered the claims 1-27 for consistency with the Examiner and have amended claims 7-9, 19, and 20-27 to repair minor typographical errors in the claims. Independent claims 1, 7, 10, 16, 19, and 25 stand rejected under 35 U.S.C § 103(a) as unpatentable over a reference entitled Java Media Framework API Guide, JMP 2.0 FCS, November 19, 1999, Sun Microsystems, page 1-66, 109-135, 173-178 (hereafter 'Sun'), in view of Application Server Solution Guide, Enterprise Edition: Getting Started, Nusbaum, et al., May 2000, pages 1-45, 416-434 (hereafter 'Nusbaum'), in further view of OpenJava: A Class-based Macro System for Java, Tatsubori, et al., July 2000, In Reflection and Software Engineering, pages 119-135 (hereafter 'Tatsubori'). As explained in detail below, applicants respectfully traverse the rejections of the present claims under 35 USC § 103(a).

To establish a prima facie case of obviousness, three elements must be proven by the Examiner. MPEP § 2142. The first element of a prima facie case of obviousness under 35 U.S.C. § 103 is that there must be a suggestion or motivation to modify or to combine Sun, Nusbaum, and Tatsubori. *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442

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(Fed. Cir. 1991). The second element of a prima facie case of obviousness under 35 U.S.C. § 103 is that there must be a reasonable expectation of success in the proposed modification or the proposed combination of Sun, Nusbaum, and Tatsubori. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). The third element of a prima facie case of obviousness under 35 U.S.C. § 103 is that the proposed modification or the proposed combination of Sun, Nusbaum, and Tatsubori must teach or suggest all of applicants' claim limitations. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). As demonstrated below, neither the modification nor the combination of Sun, Nusbaum, and Tatsubori establishes a prima facie case of obviousness. The rejection of claims 1-27 should therefore be withdrawn and the case should be allowed.

The Cited References Set Forth No Suggestion to
Modify or Combine Sun, Nusbaum, and Tatsubori

To establish a prima facie case of obviousness, there must be a suggestion or motivation to modify or combine Sun, Nusbaum, and Tatsubori. *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). The Examiner has not pointed to any disclosure in Sun, Nusbaum, or Tatsubori suggesting the desirability of the combination.

Moreover, there is no possibility whatsoever that the Examiner could ever point to any disclosure in Sun, Nusbaum, or Tatsubori suggesting the desirability of the combination. Sun in fact makes no mention whatsoever of remote director instructions or macro control of streaming digital content and therefore could not possibly suggest the desirability of the combination. Similarly, Nusbaum makes no mention whatsoever of macro control of streaming digital content and therefore could not possibly suggest the desirability of the combination. In addition, no such suggestion occurs in Tatsubori. Tatsubori presents a discussion of reflection based macros for object oriented execution

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and expresses no concern whatsoever regarding combining them with elements disclosed in other references to effect macro control of streaming digital content.

Absent such a showing of desirability, the Examiner has impermissibly used "hindsight" occasioned by applicants' own teaching to reject the claims. *In re Surko*, 11 F.3d 887, 42 U.S.P.Q.2d 1476 (Fed. Cir. 1997); *In re Vaeck*, 947 F.2d 488m 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re Gorman*, 933 F.2d 982, 986, 18 U.S.P.Q.2d 1885, 1888 (Fed. Cir. 1991); *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990); *In re Laskowski*, 871 F.2d 115, 117, 10 U.S.P.Q.2d 1397, 1398 (Fed. Cir. 1989). The proposed combination of Sun, Nusbaum, and Tatsubori therefore cannot possibly establish a prima facie case of obviousness. The objection should be withdrawn, and the case should be allowed.

There is No Reasonable Expectation Of Success in the
Proposed Combination of Sun, Nusbaum, and Tatsubori

To establish a prima facie case of obviousness, there must be a reasonable expectation of success in the proposed combination of Sun, Nusbaum, and Tatsubori. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). The Examiner has not pointed to any disclosure in Sun, Nusbaum, and Tatsubori suggesting any expectation of success. Absent such a showing of an expectation of success, the Examiner has failed to meet one of the three basic elements of a prima facie case of obviousness.

In addition, there can be no reasonable expectation of success in a proposed combination if the proposed combination changes the principles of operation of Sun, Nusbaum, or Tatsubori. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). The Office Action bases this rejection primarily on Sun. Sun is the Java Media Framework API Guide, which describes itself in its Preface at page xiii as a framework that provides an API (application programming interface) and a plug-in API that enable programmers to develop programs that present time-based media, capture and store media data, control the type of processing that is performed during playback, and perform custom processing on media data streams. No doubt the JMF API is a fine product that provides many fine

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features helpful to software developers regarding control of media data streams. Macro control of streaming digital content as claimed in the present application, however, is not a feature provided by the JMF API, and there is no way to rearrange the elements of the JMF API to include macro control of streaming digital content as claimed in the present application without changing the principles of operation of the JMF API to include them. The proposed combination of Sun, Nusbaum, and Tatsubori therefore cannot support a prima facie case of obviousness. The rejection should be withdrawn, and the case should be allowed.

Sun Teaches Away From the
Claims of the Present Application

Turning now to the substance of Sun, Sun actually teaches away from the current application. Teaching away from the claims is a *per se* demonstration of lack of prima facie obviousness. *In re Dow Chemical Co.*, 837 F.2d 469, 5 U.S.P.Q.2d 1529 (Fed. Cir. 1988); *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); *In re Neilson*, 816 F.2d 1567, 2 U.S.P.Q.2d 1525 (Fed. Cir. 1987). Sun discloses an API that enables programmers to develop programs that present time-based media, capture and store media data, control the type of processing that is performed during playback, and perform custom processing on media data streams. Clearly there would be no impulse on the part of the developers of the JMF API to incorporate macro control of streaming digital content as claimed in the present application. By disclosing the JMF API features and functions alone, with no hint or suggestion that macro control of streaming digital content as claimed in the present application might even exist, Sun teaches directly away from the macro control of streaming digital content as claimed in the present application. Because Sun teaches away from the applicants claims, the proposed modification of Sun with Nusbaum and Tatsubori cannot support a prima facie case of obviousness. The rejection of applicants' claims should be withdrawn and the case should be allowed.

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Sun, Nusbaum, and Tatsubori Do Not Teach
Each and Every Element of the Claim

To establish a prima facie case of obviousness, the proposed combination of Sun, Nusbaum, and Tatsubori must disclose all of applicants' claim limitations. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). There is not one word in Sun, Nusbaum, or Tatsubori regarding macro control of streaming digital content, macros comprising a URL and a first time, remote director instructions, macros being stored in the order in which the URLs are first invoked through hyperlinks, reading the macros in the order in which the macros were stored, invoking each URL of each macro as a hyperlink at a second time, formulating and issuing a remote director instruction, and so on, as claimed in the present application. The fact that Sun makes general references to streaming media, that Nusbaum makes some general references to network communications, or that Tatsubori describes reflection based object oriented macros having nothing to do with the claimed invention is completely insufficient to anticipate or suggest claim elements in the present application. This ground of rejection should be withdrawn.

Sun Cannot be a Reference Against the Claims of the Present
Application Because Sun Represents Nonanalogous Art

Sun cannot be a reference against the claims of the present application because Sun represents nonanalogous art within the meaning of *In Re Horn*, *Clay*, and *Oetiker*. *In re Horn*, 203 USPQ 969 (CCPA 1979), *In re Clay*, 966 F.2d 656, 23 USPQ2d 1058 (Fed. Cir. 1992), *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). The field of the inventors' effort in this case is macro control of streaming digital content. The present application claims, among other things, macros comprising a URL and a first time, remote director instructions, macros being stored in the order in which the URLs are first invoked through hyperlinks, reading the macros in the order in which the macros were stored, invoking each URL of each macro as a hyperlink at a second time, formulating and issuing a remote director instruction, and so on, as claimed in the present

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application. The field of Sun is a Java framework that present an API, a particular API that enables programmers to develop programs that present time-based media, capture and store media data, control the type of processing that is performed during playback, and perform custom processing on media data streams – clearly having nothing to do with the technical field of the present application. Sun therefore is not within the field of the inventor's endeavor in this case.

Because Sun is not within the field of the inventor's endeavor in this case, there can be no basis for believing that Sun as a reference would have been considered by one skilled in the particular art working on the relevant problem to which this invention pertains. That is, there would be no reason for an inventor concerned with macro control of streaming digital content to search for art regarding Sun's JMF API, which has no operability or functionality related to macro controls. The two simply have nothing to do with one another. Sun as a reference therefore is not reasonably pertinent to the particular problem with which the inventors were involved in the present case and is not available as a reference against the present application. Applicants respectfully propose that for this reason alone the rejection of the present claims should be withdrawn, and the claims should be allowed.

Conclusion

All claims in the present case stand rejected under 35 U.S.C § 103(a). Independent claims 1, 7, 10, 16, 19, and 25 stand rejected under 35 U.S.C § 103(a) over Sun in view of Nusbaum further in view of Tatsubori. The combination of Sun, Nusbaum, and Tatsubori fails to establish a prima face case of obviousness. The applicants have demonstrated that it is incorrect to reject the independent claims 1, 7, 10, 16, 19, and 25 under 35 U.S.C § 103(a). The applicants respectfully propose that all the dependent claims in the present case stand because the independent claims 1, 7, 10, 16, 19, and 25 stand. The rejection of all the claims 1 - 27 should therefore be withdrawn, and the claims should be allowed. Reconsideration of claims 1-27 in light of the present remarks is respectfully requested.

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The Commissioner is hereby authorized to charge or credit Deposit Account No. 09-0447 for any fees required or overpaid.

Respectfully submitted,

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